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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/787,119	03/14/2001	Daisuke Yano	010324	6260
23850	7590	08/19/2004	EXAMINER	
ARMSTRONG, KRATZ, QUINTOS, HANSON & BROOKS, LLP			UHLIR, NIKOLAS J	
1725 K STREET, NW			ART UNIT	PAPER NUMBER
SUITE 1000				1773
WASHINGTON, DC 20006			DATE MAILED: 08/19/2004	

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/787,119	YANO ET AL.
	Examiner Nikolas J. Uhli	Art Unit 1773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address. --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on 22 July 2004.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) 6-11 and 17-19 is/are withdrawn from consideration.
- 5) Claim(s) _____ is/are allowed.
- 6) Claim(s) 1-5 and 12-16 is/are rejected.
- 7) Claim(s) _____ is/are objected to.
- 8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 03/14/2003.
- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: _____.

DETAILED ACTION

Election/Restrictions

1. Applicant's election of claims 1-5 and 12-16 in the reply filed on 7/22/04 is acknowledged. Because applicant did not distinctly and specifically point out the supposed errors in the restriction requirement, the election has been treated as an election without traverse (MPEP § 818.03(a)).
2. Claim 6-11 and 17-19 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on 7/22/04.

Priority

3. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Drawings

4. The drawings are objected to under 37 CFR 1.83(a) because they fail to show numeral 8 and numeral 9 in figure 4, as described in the specification at page 19 paragraph 2. Any structural detail that is essential for a proper understanding of the disclosed invention should be shown in the drawing. MPEP § 608.02(d). Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an

amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-3 and 12-14 are rejected under 35 U.S.C. 102(e) as being anticipated by Suzuki et al. (US5972438).

7. Claim 1 requires a transferable magnetic tape in which a printed layer, a magnetic recording layer, and an adhesive layer are layered in sequence upon a backing film with said printed layer closest to said backing film, wherein said printed

layer comprises: a pattern printed region and, a filling layer region outside the pattern printed region, and moreover a thickness of said printed layer is uniform, and in said transferable magnetic tape a coercivity of magnetic powder contained in said magnetic recording layer is 20-320 kA/m.

8. The examiner notes that "printed in sequence" does not require the recited layers to be in direct contact with one another. For example, a magnetic tape having a printed layer, protective layer, magnetic layer, and adhesive layer formed in this order meets applicants requirement that the recited layers be formed in sequence.

9. Suzuki discloses a magnetic tape comprising a holding material 90 (equivalent to applicants claimed backing material), a peeling layer 91, a protective layer 93, a 2nd magnetic layer 95, a first magnetic layer 96, and an adhesive layer 98 (equivalent to applicants claimed adhesive) formed in this order (see figure 19, and column 12, lines 49-column 13, line 10). Suzuki discloses that the second magnetic layer can comprise non-erasable and non-alterable coding information, such as a bar code pattern or letters (column 2, lines 60-66). As a bar code pattern or pattern of letters includes a pattern printed region and a filling layer region outside the printed region, the 2nd magnetic layer 95 of Suzuki is considered to be equivalent to applicants claimed printed layer having a pattern printed region and a filling layer region. In specific embodiments, the thickness of the 2nd magnetic layer is disclosed to be 6 μ m (column 27, lines 20-30). From this disclosure and from the diagrams, it is apparent that the coating thickness of the second magnetic layer is uniform. Thus, the second magnetic layer of Suzuki meets all of the limitations of the applicant's claimed pattern printed layer. The 1st magnetic

layer 96 is comprised of magnetic particles and a binder (column 12, lines 15-25).

Suitable magnetic particles include gamma iron oxide (coercivity of 250-400Oe), Cobalt clad gamma iron oxide (coercivity of 600-700Oe), and barium ferrite (coercivity of 1600-1900Oe or 2500-3000Oe) (column 12, lines 3-8). As applicants claimed coercivity range of 20-320 kA/m is equivalent to 251-4021Oe, it is clear that the magnetic particles of Suzuki meet the claimed coercivity range. Thus, the first magnetic layer of Suzuki is equivalent to applicant's claimed magnetic layer having a specific coercivity. Finally, it is noted that Suzuki teaches that this magnetic tape forms a magnetic transfer tape (column 29, lines 25-35).

10. Thus, Suzuki anticipates all of the limitations of claim 1.

11. Claim 2 requires the patterned printed region and filling layer region to comprise a printing ink. The examiner notes that the term "printing ink," is not defined in the specification or the claims. As it is the examiners duty to give the claims their broadest reasonable interpretation, the examiner interprets the term "printing ink" as being read on by any prior art material that is capable of bring printed, i.e. particles in a binder.

12. Bearing the above interpretation in mind, Suzuki teaches that the magnetic coding is formed by dispersing magnetic particles in a solution of binder and solvent, followed by coating the solution onto the support and drying the solution. The examiner interprets the coating process taught by Suzuki to be equivalent to a printing process. Thus, the examiner interprets the coding layer of Suzuki, which comprises particles in a binder and is applied via a printing process, to be equivalent to applicants claimed "printing ink."

13. Claim 3 requires a resin layer having peelability to be provided between the backing film and the printed layer. As discussed above for claim 1, Suzuki discloses the use of a peeling film 91 between a holding material 90 and the second magnetic (coding) layer 95. Thus, Suzuki anticipates this limitation.

14. Claim 12 basically requires the same limitations as claim 1, except that it requires a magnetic card. Suzuki specifically teaches that the transferable magnetic tape is useful for forming a magnetic stripe on a magnetic card (column 1, lines 10-20 and column 17⁺ "examples"). Thus, Suzuki anticipates the limitations of claim 12.

15. Claims 13 and 14 and met as set forth above for claims 12 and 1.

Claim Rejections - 35 USC § 103

16. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

17. Claims 4-5 and 15-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Suzuki as applied to claims 1 and 12 above, and further in view of Kubota (US4132350).

18. Suzuki as set forth above for claims 1 and 12 does not teach the use of a masking layer between the patterned layer and the magnetic layer as required by claims 4-5 and 15-16.

19. However, Kubota teaches a magnetic card comprising a card base, a magnetic layer on the substrate, a color layer on the magnetic layer, and a pattern layer on the

color layer (column 1, lines 37-42). The patterned layer comprises a pigment in a binder, and forms letters or marks (column 3, line 65-column 4, line 17). The magnetic layer comprises ferromagnetic particles in a binder (column 3, lines 40-50). The color layer comprises a pigment or dye with high hiding power dissolved in a binder (column 3, lines 50-65). By providing the color layer between the magnetic layer and the printed layer, the unattractive color of the magnetic layer is hidden and as a result the appearance of the patterned layer is improved (column 1, lines 25-36).

20. Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to place the color layer taught by Kubota between the magnetic layer and the coded layer of Suzuki.

21. One would have been motivated to make this modification in view of the fact that Suzuki teaches that the appearance of a patterned layer over a magnetic layer is improved by providing a colored layer between the patterned layer and the magnetic layer. One would have been further motivated in view of the fact that the patterned layer of Suzuki forms a pattern of letters, marks, or a bar code over a magnetic recording layer, and so is substantially similar to the patterned layer of Kubota.

22. The examiner notes that the colored layer of Kubota is considered to be equivalent to applicants claimed masking layer. The colored layer is specifically taught to have "high hiding power" and functions to hide the color of the magnetic layer. This function is equivalent to that of a masking layer.

23. As set forth above, the combination Suzuki with Kubota meet all of the limitations of claims 4-5 and 15-16

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Nikolas J. Uhlir whose telephone number is 571-272-1517. The examiner can normally be reached on Mon-Fri 7:30 am - 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Deborah Jones can be reached on 571-272-1535. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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